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| 10/678,048  | 10/02/2003  | Diane Nerby          | 927-001             | 6647             |
| 7590  | 12/16/2009  |                      | EXAMINER            |                  |
| WARD & OLIVO<br>Suite 300<br>382 Springfield Avenue<br>Summit, NJ 07901 |             |                      | PADOT, TIMOTHY      |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |
|------------------------------|--------------------------------------|-------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/678,048 | <b>Applicant(s)</b><br>NERBY, DIANE |
|                              | <b>Examiner</b><br>TIMOTHY PADOT     | <b>Art Unit</b><br>3624             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 02 October 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-52 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-52 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 06 December 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/GS-68)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

**Status of Claims**

1. This communication is a First Office Action on the merits in reply to application number 10/678,048 filed on 10/02/2003.
2. Claims 1-52 are currently pending and have been examined.

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 34-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 34-49 recite various means in the limitations: *questionnaire means, compilation means, security means, connection means, display means, statistical analysis means, and tracking means*. The recited means plus function limitations may invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. Applicant is required to:

- Amend the claims so that the limitations will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- State on the record where the corresponding structure, material, or acts are set forth in the written description or the specification that perform the claimed functions.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181. For purposes of examination, it will be understood that each of the apparatus and various recited means is embodied in tangible components.

#### Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-33 and 50-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claims 1-33 and 50-52 are drawn to a *method for optimizing performance*. However, the recited method steps are drawn to non-statutory subject matter because the recited steps are (1) not tied to a particular machine or apparatus, or (2) not transforming the underlying subject matter (such as an article or materials) to a different state or thing.

Based on Supreme Court precedent, a process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplishes the method steps or by positively reciting the subject matter being transformed, for example by identifying the material that is being changed to a different state.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) It is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See *Benson*, 409 U.S. at 70 ("Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines."); *Diehr*, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also *Flook*, 437 U.S. at 589 n.9 ("An argument can be made [that the Supreme] Court has only recognized a

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process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing''); *Cochrane v. Deener*, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject- matter to be transformed and reduced to a different state or thing.'). A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008)).

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)). Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.*, (Appeal 2008-1495).

#### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**9. Claims 1-3, 6-7, 10-15, 17-18, 21-24, 26-29, 31-34, 36-39, 41, and 44-52 are rejected under 35 U.S.C. 103(a) as unpatentable** over "SurveySaid" (SurveySaid Survey Enterprise Edition - Specifications) in view of MacKenzie (Pub. No.: US 2002/0065709 A1).

**10. Claim 1/50/51/52:**

SurveySaid teaches a method for optimizing performance comprising:

- *providing at least one online questionnaire to at least one individual* (page 1: multi-user capabilities; no limit to number of respondents; see also, page 2: survey may be administered on touch screen PC system, standalone desktop PC, networked PC, via Internet, by Mail Diskette, Printed Paper);
- *compiling results of said at least one questionnaire into at least one database* (page 3: survey data may be imported from Survey Said databases or imported/exported to other applications; see also, page 5: results may be cut and pasted to other applications, and analysis may be printed in formatted tables);
- *displaying said results of said at least one questionnaire* (page 5: "Over 25 different graphic charts can be selected from. Display the graphs on the screen or send them to your printer in either color or black and white. Survey Said takes full advantage of high resolution printers generating charts with professional appearance. Use categories to enhance breakdown analysis. Up to 500 Top and Sub category combinations can be defined to allow very detailed grouping analysis. Compare categories to each other or to the total responses." See also, page 3: Standard Report includes, *inter alia*, analysis printed in tables, graphs, reports).

SurveySaid does not expressly teach:

- *applying said results of said at least one questionnaire for said optimizing.*

However, MacKenzie teaches *applying said results of said at least one questionnaire for said optimizing* (paragraphs 19 and 22) in an analogous art of employee opinion and organizational diagnostic survey administration for the purpose of producing recommendations for organizational improvement.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie in order to provide the benefit of improved organizational performance through application of the results to areas of potential improvement (MacKenzie at paragraphs 19 and 22), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**11. Claims 2/36:** SurveySaid in view of MacKenzie teaches the limitations of claims 1/34.

SurveySaid further teaches:

- *wherein said providing is facilitated by at least one network* (page 4: survey may be administered over various networks, including Local Area Networks, Wide Area Networks, and the Internet).

**12. Claims 3/37/39:** SurveySaid in view of MacKenzie teaches the limitations of claims 2/36/38.

SurveySaid further teaches:

- *wherein said network is selected from the group consisting of an internet, an intranet, a wireless network, a cellular network, a wide area network, a local area network, a virtual private network, a token ring network, and a dial-up network* (pages 2 and 4: networks include Internet, Local Area Network, Wide Area Network, networked kiosks).

**13. Claims 6/14/44:** SurveySaid in view of MacKenzie teaches the limitations of claims 1/34.

SurveySaid further teaches:

- *wherein said results are displayed online* (page 3: All Survey Said programs are Network Ready; see also, page 4: Administration Environments include, *inter alia*, Local and Wide Area Networks and Internet).

**14. Claims 7/45:** SurveySaid in view of MacKenzie teaches the limitations of claims 1/34.

SurveySaid does not teach:

- *wherein at least part of said results of said individual are displayed to at least one person other than said individual.*

However, MacKenzie teaches *displaying results to at least one person other than said individual* (paragraph 19). Further, sending survey results to multiple individuals or making results accessible so multiple individuals is in accordance with old and well known convention in the art.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie, including a step for displaying survey results to at least one other person, in order to provide the benefit of improved organizational performance through application of the results to areas of potential improvement (MacKenzie at paragraphs 19 and 22), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**15. Claim 10:** SurveySaid in view of MacKenzie teaches the limitations of claim 1.

SurveySaid further teaches:

- *wherein at least part of said results is sorted* (page 2: analysis may include verbatim sorting by a fixed choice question; ranking tables; multi-field numeric grouping; cross tables).

**16. Claims 11/41:** SurveySaid in view of MacKenzie teaches the limitations of claims 1/34.

SurveySaid further teaches:

- *wherein at least part of said results is statistically analyzed* (page 5: survey data may be analyzed in banner, cross table, or frequency format, including counts/percent next to answers; categorical breakdown analysis).

**17. Claim 12:** SurveySaid in view of MacKenzie teaches the limitations of claim 1.

SurveySaid further teaches:

- *wherein at least part of said results is summarized* (pages 2 and 3: frequency analysis, banner grouping, tables and graphs, categorical breakdowns).

18. Claim 13: SurveySaid in view of MacKenzie teaches the limitations of claim 1.

SurveySaid further teaches:

- *further comprising the step of quantitatively analyzing said results* (page 2: frequency of answers by count and percent; ranking tables and graphs; multi-field numeric grouping).

19. Claim 14: SurveySaid in view of MacKenzie teaches the limitations of claim 1.

SurveySaid further teaches:

- *further comprising the step of qualitatively analyzing said results* (page 3: categorically enhance breakdown of survey results; detailed grouping analysis).

20. Claims 15/46: SurveySaid in view of MacKenzie teaches the limitations of claims 1/34.

SurveySaid further teaches:

- *wherein said questionnaire comprises at least one question, said question being in a format selected from the group consisting of multiple-choice, ranking, and written answer* (page 1: Question Specification includes, *inter alia*, multiple choice, ranking, and verbatim question/answer types).

21. Claim 17: SurveySaid in view of MacKenzie teaches the limitations of claims 1.

SurveySaid does not expressly teach:

- *wherein said performance comprises individual performance.*

However, MacKenzie teaches wherein said performance comprises individual performance (at least paragraph 7: performance of a particular instructor is measured via a Curriculum and Instruction Survey) in an analogous art of employee opinion and organizational diagnostic survey administration for the purpose of producing recommendations for organizational improvement. Further, conducting surveys for the end purpose of rating, critiquing, or improving individual performance is old and well known.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie in order to provide the benefit of improved individual performance through application of the results to areas of potential improvement (MacKenzie at paragraphs 19 and 22) or perhaps to identify areas of success, and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**22. Claim 18: SurveySaid in view of MacKenzie teaches the limitations of claim 1.**

SurveySaid does not teach:

- *wherein said performance comprises business performance.*

However, MacKenzie teaches wherein *said performance comprises business performance* (paragraphs 19 and 22: results are often useful to management in evaluating its current policies and performance) in an analogous art of employee opinion and organizational diagnostic survey administration for the purpose of producing recommendations for organizational improvement. Further, conducting surveys for the end purpose of improving business performance is old and well known in the field of business management.

It would have been obvious to combine SurveySaid with MacKenzie, including a business performance optimization application, in order to provide the benefit of improved organizational performance through application of the results to areas of potential improvement (MacKenzie at paragraphs 19 and 22), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**23. Claim 21: SurveySaid in view of MacKenzie teaches the limitations of claim 1.**

SurveySaid does not teach:

- *wherein said individual is a member of an organization.*

However, MacKenzie teaches wherein *said individual is a member of an organization* (paragraphs 6 and 19) in an analogous art of employee opinion and organizational diagnostic survey administration for the purpose of producing recommendations for organizational improvement. Further, administering surveys to members of an organization for the end purpose of improving organizational performance is old and well known in the field of business management.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie, including a feature wherein the individual is a member of an organization, in order to provide the benefit of improved organizational performance through application of survey results in pursuit of corresponding areas in need of improvement as identified by the members, and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**24. Claims 22/48:** SurveySaid in view of MacKenzie teaches the limitations of claims 21/34.

SurveySaid further teaches:

- *wherein said at least one questionnaire is customized for said organization* (page 4: Customization can be obtained on a case by case basis).

**25. Claims 23/47:** SurveySaid in view of MacKenzie teaches the limitations of claims 1/34.

SurveySaid further teaches:

- *wherein said at least one questionnaire is customized for said individual* (page 4: Customization can be obtained on a case by case basis).

**26. Claim 24:** SurveySaid in view of MacKenzie teaches the limitations of claim 1.

SurveySaid further teaches:

- *further comprising the step of determining the gap between said individual's desired state and said individual's actual state* (page 1: supports Dual Scale for gap analysis).

**27. Claims 26/27:** SurveySaid in view of MacKenzie teach the limitations of claims 21 as shown above.

SurveySaid does not expressly teach:

- *further comprising the step of displaying at least part of said results to at least one member of a different organization.*

However, MacKenzie teaches the step of *displaying at least a part of said results to at least one member of a different organization* (paragraph 154: client, working with the consultant, selects final recommendations for taking action to improve the results and the organization).

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie, including a feature displaying results to at least one member of a different organization, in order to provide the benefit of enhanced survey analysis by employing the services of an unbiased party (i.e., consultant, specialist, troubleshooter) for explaining and/or applying aid results in accordance with organizational needs and expectations, and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 27, which recites *wherein said organization is part of a "virtual enterprise,"* the examiner notes that the combination of SurveySaid and MacKenzie already teaches the functional limitations for performing the invention of claim 27 since claim 27 merely states an intended use of the invention and furthermore would operate in an identical or at least substantially similar manner wherein the organization happens to be a "virtual enterprise" since a virtual enterprise is merely an abstraction for an association between entities for a common purpose (i.e., an organization). Further, the examiner takes Official Notice that virtual enterprises are old and well known in the art, and therefore merely an obvious application of the invention. Thus, claim 27 recites no additional functional or structural limitations beyond those already addressed and is therefore rejected using the same art and same or substantially similar reasons set forth above.

**28. Claim 28:** SurveySaid in view of MacKenzie teach the limitations of claims 21 as shown above.

With respect to claim 28, MacKenzie provides functionality for providing varied question formats (see page 1: Question Specifications), but does not expressly teach:

- *wherein said questionnaire comprises questions on topics selected from the group consisting of self appraisal, appraisal of said organization, project goals, customer service, work environment, leadership, communication, educational programs, personal goals, ideas, perspectives, feedback, and relationships.*

However, MacKenzie teaches wherein said questionnaire comprises questions on various topics, including at least *appraisal of the organization, leadership, relationships* in the organization (paragraph 19: surveys include items such as "employee satisfaction with leadership, compensation, direction of the organization, treatment by management, ethics, and many others."). Furthermore, recitation of particular types of questions in the language of the claims fails to distinguish the claimed invention from the prior art in terms of patentability because such language fails to positively recite structure and/or functionality and is reasonably construed as non-functional descriptive material and/or a statement of intended use and thus fails to distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Furthermore, it would have been obvious to one of ordinary skill in the art to combine SurveySaid/MacKenzie with the various question topics recited in the claim because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable

29. Claims 29/49: SurveySaid in view of MacKenzie teaches the limitations of claims 21/34.

SurveySaid further teaches:

- *wherein at least part of said results of said member are displayed in a format containing at least one of a category, importance, score, gap, and comments* (page 1: Question Specifications includes gap analysis and feature for ranking items in order of importance page 4: unique category feature; page 5: optional comment field ).

30. Claim 31: SurveySaid teaches the limitations as shown in the rejection of claim 1.

SurveySaid does not expressly teach:

- *wherein said optimizing comprises the step of creating a shared view.*

However, MacKenzie teaches the optimizing as comprising the step of creating a shared view (at least paragraphs 4-6). Further, collaboration among organizational entities (e.g., managers and subordinates) for creating shared views with respect to organizational direction, possible improvements, and the like, is old and well known.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie, including a feature wherein optimizing comprises the step of creating a shared view, because there is a need in the art to know more about the opinions of employees respecting the organization as such is important to the success of the organization (MacKenzie at paragraph 5), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

31. Claim 32: SurveySaid teaches the limitations as shown in the rejection of claim 1.

SurveySaid does not expressly teach:

- *wherein said optimizing comprises the step of obtaining feedback.*

However, MacKenzie teaches *wherein said optimizing comprises the step of obtaining feedback* (paragraphs 6, 22, and 141: employee opinions are surveyed regarding various items). Further, collaboration among organizational entities (e.g., managers and subordinates) for creating shared views with respect to organizational direction, possible improvements, and the like, is old and well known.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie, including a feature wherein optimizing comprises the step of obtaining feedback, because there is a need in the art to know more about the opinions of employees respecting the organization as such is important to the success of the organization (MacKenzie at paragraph 5), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**32. Claim 33:** SurveySaid teaches the limitations as shown in the rejection of claim 21.

SurveySaid does not expressly teach:

- *wherein said performance comprises the performance of a "virtual enterprise", wherein said organization is part of said "virtual enterprise."*

However, MacKenzie teaches *wherein performance comprises the performance of an organization* (paragraphs 19 and 22: results are often useful to management in evaluating its current policies and performance), but does not expressly refer to a virtual enterprise. However, referencing performance of a virtual enterprise as the organization of interest merely states an intended use of the invention, and furthermore the underlying functionality would be executed in an identical or at least substantially similar manner wherein the organization happens to be a "virtual enterprise" since a virtual enterprise is merely an abstraction for an association between entities for a common purpose (i.e., an organization). Further, the examiner takes Official Notice that virtual enterprises are old and well known in the art, and therefore merely an obvious application of the invention.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie, including a feature wherein *said performance of the organization is with respect to a virtual organization*, in order to apply survey results to improve the cohesion, performance, or alignment of the virtual enterprise, and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**33. Claim 34:**

SurveySaid teaches an apparatus (page 2: PC systems, networked PCs; page 4: networked kiosks) comprising:

- *questionnaire means for providing at least one online questionnaire designed to be completed by at least one individual* (page 1: multi-user capabilities; no limit to number of respondents; see also, page 2: survey may be administered on touch screen PC system, standalone desktop PC, networked PC, via Internet, by Mail Diskette, Printed Paper);
- *compilation means for compiling results of said questionnaire* (page 3: survey data may be imported from Survey Said databases or imported/exported to other applications; see also, page 5: results may be cut and pasted to other applications, and analysis may be printed in formatted tables); and
- *at least one database, wherein said results are stored* (page 3: SurveySaid databases allow importing/exporting; page 6: data can be exported to SQL database servers);

SurveySaid does not expressly teach:

- *wherein said results can be used to optimize performance.*

However, MacKenzie teaches *wherein said results can be used to optimize performance* (paragraphs 19 and 22) in an analogous art of employee opinion and organizational diagnostic survey administration for the purpose of producing recommendations for organizational improvement.

It would have been obvious to one of ordinary skill in the art to combine SurveySaid with MacKenzie in order to provide the benefit of improved organizational performance through application of the results to areas of potential improvement (MacKenzie at paragraphs 19 and 22), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

34. Claim 38: SurveySaid in view of MacKenzie teach the limitations of claim 34 as shown above.

SurveySaid further teaches:

- *wherein said questionnaire means and said database are connected by connection means* (pages 1-3: teaches various means and options linking questionnaire means to a database, such as a network connection between PCs on a LAN/WAN and importing/exporting functionality for importing/exporting survey data).

35. Claims 4-5, 9, 30, 35, 40, and 42-43 are rejected under 35 U.S.C. 103(a) as unpatentable over "SurveySaid" (SurveySaid Survey Enterprise Edition - Specifications) in view of MacKenzie (Pub. No.: US 2002/0065709 A1), as applied to claims 1-3, 6-7, 10-15, 17-18, 21-24, 26-29, 31-34, 36-39, 41, and 44-52 above, in further view of "SurveySolutions" (Perseus Survey Solutions Enterprise).

36. Claims 4/42: SurveySaid in view of MacKenzie teach the limitations of claims 1/34.

SurveySaid and MacKenzie do not expressly teach:

- *further comprising the step of chronologically tracking the progress of said results.*

However, SurveySolutions teaches *chronologically tracking the progress of said results* (page 4: users can monitor "real-time" results as they are written to the database table) in an analogous art of internet-based survey administration tools. In addition, employing a tool for tracking the progress of an activity is old and well known.

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It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine SurveySaid/MacKenzie with a feature for chronologically tracking results progress, as taught by SurveySolutions, in order to provide the advantage of filtering the data (e.g., delete duplicate response) before exporting to a database (SurveySolutions at page 4), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

37. Claims 5/40/43: SurveySaid in view of MacKenzie teach the limitations of claim 1/34.

SurveySaid and MacKenzie do not expressly teach:

- *further comprising the step of displaying said results in real-time*

However, SurveySolutions teaches *displaying said results in real-time* (page 2: real-time accessibility to survey results from the desktop; see also, page 4: users can monitor "real-time" results as they are written to the database table) in an analogous art of internet-based survey administration tools. In addition, monitoring and displaying results of an activity in real-time is old and well known.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine SurveySaid/MacKenzie with a feature for displaying real-time results, as taught by SurveySolutions, in order to provide the advantage of filtering the data (e.g., delete duplicate response) before exporting to a database (SurveySolutions at page 4), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

38. Claims 9/35: SurveySaid in view of MacKenzie teach the limitations of claims 1/34.

SurveySaid and MacKenzie do not expressly teach:

- *wherein said at least one database requires authorized access.*

However, SurveySolutions teaches a step wherein *at least one database requires authorized access* (pages 1 and 6: security and control features are provided for results stored within an SQL database).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine SurveySaid/MacKenzie with a feature for securing/controlling access to a database storing survey results, as taught by SurveySolutions, in order to provide the benefit of ensuring the integrity of the data in addition to protection of sensitive information (e.g., trade secrets, respondents' personal information, etc.), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 35 recites limitation(s) substantially similar to the limitation(s) of claim 9 and is therefore rejected using the same art and same or substantially same reasons set forth above.

**39. Claim 30: SurveySaid in view of MacKenzie teaches the limitations of claim 1.**

SurveySaid and MacKenzie do not expressly teach:

- *wherein said optimizing comprises the step of improving said individual's work environment.*

However, SurveySolutions teaches the optimizing as comprising the step of improving said individual's work environment (page 1, paragraph 1). Further, applying survey results to improve the work environment based on findings is an old and well known optimization tool in the field of human resource management.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine SurveySaid/MacKenzie with a feature for improving said individual's work environment in furtherance of optimization, as taught by SurveySolutions, in order to provide the benefit of increased employee satisfaction and thus productivity, and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**40. Claims 8, 16, 19-20, and 25 are rejected under 35 U.S.C. 103(a) as unpatentable** over "SurveySaid" (SurveySaid Survey Enterprise Edition - Specifications), in view of MacKenzie (Pub. No.: US 2002/0065709 A1), as applied to claims 1-3, 6-7, 10-15, 17-18, 21-24, 26-29, 31-34, 36-39, 41, and 44-52 above, in further view of OFFICIAL NOTICE.

**41. Claim 8:** SurveySaid in view of MacKenzie teach the limitations of claim 1.

SurveySaid and MacKenzie do not expressly teach *wherein said results displayed vary depending on the person viewing said results*. However, the examiner takes Official Notice that varying displayed survey results depending on the viewer is old and well known in the art (e.g., displaying results relative to a corresponding organizational unit, management position, etc.). In addition, it would obvious and expected, if not inherent, that each survey respondent's results displayed/summarized upon completion of the survey would be different from another survey respondent's results, and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**42. Claim 16:** SurveySaid in view of MacKenzie teach the limitations of claim 1.

SurveySaid and MacKenzie do not expressly teach the step of *providing said individual with suggestions, help or tools for improvement*. However, the examiner takes Official Notice that providing recommendations (e.g., suggestions, help, tools) for improving individual performance based on information extracted from a survey is old and well known in the art, and such tools (assessments, aptitude batteries, etc.) have long been employed by institutions, organizations, and the like. Further, merely adding a step for providing and individual with suggestions, help or tools for improvement would have been obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**43. Claims 19/20:** SurveySaid in view of MacKenzie teach the limitations of claim 1.

SurveySaid and MacKenzie do not expressly teach *wherein said performance comprises team performance and wherein said team performance comprises at least one selected from the group consisting of innovation, engagement, alignment, productivity, and collaboration*. However, the examiner takes Official Notice that taking steps aimed toward improving team performance, including areas such as team cohesion (i.e., engagement and alignment) and team productivity, based on information extracted from surveys is old and well known in the art, often employed for the purpose of evaluating the performance of a team and its contribution to the organization, and thus would have been obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**44. Claim 25:** SurveySaid in view of MacKenzie teach the limitations of claim 21.

SurveySaid and MacKenzie do not expressly teach wherein said performance comprises *employee and management performance within said organization*. However, the examiner takes Official Notice that administering a survey to members of an organization and taking steps or making changes aimed toward across-the-board organizational improvement, including employee and management performance improvement, based on information extracted from surveys is old and well known in the art, and such an application of the invention would have been obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kim (Pub. No.: US 2005/0075919 A1) teaches a method/system for real time respondent based surveying (paragraph 8) suitable for conducting employee-satisfaction surveys (paragraph 2).
- Ammerman et al. (Pub. No.: US 2003/0115094) teaches an apparatus and method for evaluating performance of a business and/or the employees of the business, including computer-based survey instruments for evaluation (paragraph 37) and analysis of results (paragraphs 87 et seq.).
- Brookler et al. (Pub. No.: US 2002/0007303 A1) teaches a system for conducting electronic surveys including a survey results analysis engine (paragraphs 30-31,64-65) and anonymity functionality (paragraphs 62-63).

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Timothy A. Padot whose telephone number is 571.270.1252. The Examiner can normally be reached on Monday-

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Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Bradley B. Bayat can be reached at 571.272.6704.

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TIMOTHY PADOT

Examiner, Art Unit 3624

12/08/2009

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Supervisory Patent Examiner, Art Unit 3624